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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/758,737	01/16/2004	Kevin T. Burt	TIM1537-299C	6381
8698 7590 11/09/2009 STANDLEY LAW GROUP LLP 6300 Riverside Drive Dublin, OH 43017				
EXAMINER				
CHEVALIER, ALICIA ANN				
ART UNIT		PAPER NUMBER		
1794				
MAIL DATE		DELIVERY MODE		
11/09/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/758,737

**Applicant(s)**

BURT ET AL.

**Examiner**

ALICIA CHEVALIER

**Art Unit**

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 August 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3, 5-16 and 18-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-16 and 18-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/S5108)  
Paper No(s)/Mail Date 8/12/09
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**RESPONSE TO AMENDMENT**

1. Claims 1-3, 5-16 and 18-22 are pending in the application, claims 4 and 17 have been cancelled.
2. Amendments to the claims, filed on August 11, 2009, have been entered in the above-identified application.

***WITHDRAWN REJECTIONS***

3. The 35 U.S.C. §112 rejections of claims 1-3, 5-16 and 18-22, made of record in the office action mailed September 2, 2008, pages 2-3, paragraphs #6-8 have been withdrawn due to Applicant's amendment in the response filed August 11, 2009.

***REJECTIONS***

4. **The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.**

***Claim Rejections - 35 USC § 102***

5. Claims 1-3, 5-16 and 18-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Nakao (U.S. Patent No. 5,443,887).

Regarding Applicant's claims 1, 5, 7, 9, 11, 14, 20 and 22, Nakao discloses a component comprising: a metal substrate having a perforation (*col. 6, line 21*); and a composite outer layer comprising a plastic and at least one filler, wherein the filler is selected from the group

consisting of cellulosic fillers and inorganic fillers (*col. 6, lines 26-27 and col. 2, lines 1-5 and lines 40-42*), said composite formed on said substrate such that all sides of said substrate are coated by said outer layer and said composite passes through said perforation in said substrate (*col. 1, lines 12-13, col. 6 lines 11-20 and the figures*).

The limitation “rail” and “for deck railing” is deemed to be a statement with regard to the intended use and is not further limiting in so far as the structure of the product is concerned. In article claims, a claimed intended use must result in a ***structural difference*** between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. MPEP § 2111.02. Furthermore, the article of Nakao is deemed to be a “rail system,” because Nakao meets all the structural limitations of the claims.

Regarding Applicant’s claims 2, 3, 10, 15 and 16, Nakao discloses the substrate is a sheet (*figures 1 and 2*) and substrate is deemed to have a higher bending strength than a comparable size piece of said composite, since Nakao’s component has the same claimed structure and composition.

Regarding Applicant’s claims 6, 12 and 19, Nakao discloses said plastic is selected from the group consisting of polyethylene, polypropylene, and polyvinyl chloride (*col. 4, lines 3-29*).

Regarding Applicant’s claims 8, 13 and 21, the limitation “said composite is formed about said substrate by a process selected from the group consisting of extrusion, compression molding, and injection molding” is a method limitation and does not determine the patentability of the product, unless the process produces unexpected results. The method of forming the product is not germane to the issue of patentability of the product itself, unless Applicant presents evidence from which the Examiner could reasonably conclude that the claimed product

differs in kind from those of the prior art. MPEP 2113. Furthermore, there does not appear to be a difference between the prior art structure and the structure resulting from the claimed method because Nakao discloses claimed structure of claims 1, 9 and 14.

Regarding Applicant's claim 18, Nakao discloses said substrate has a plurality of perforations through which the composite passes (*figures 1 and 2*).

#### ***ANSWERS TO APPLICANT'S ARGUMENTS***

6. Applicant's arguments in the response filed August 11, 2009 regarding the 35 USC 112 rejections of record have been considered but are moot since the rejections have been withdrawn.
7. Applicant's arguments in the response filed August 11, 2009 regarding the 35 U.S.C. 102(b) rejection over Nakao of record have been carefully considered but are deemed unpersuasive.

Applicant argues that one of skilled in the art would not recognize any relationship between a rail and a gasket. Applicant further states that Nakao does not provide any motivation that a rail for deck railing could be successfully made based on the description of a gasket with limited dimensions as described by Nakao.

The limitations on which the Applicant relies (i.e. the dimensions of the rail) are not stated in the claims. It is the claims that define the claimed invention, and it is claims, not specifications that are anticipated or unpatentable. Also, a "rail" can be any size such as small as 1/8" for pieces in a doll house up several feet for industrial applications. Furthermore, Applicant has failed to show the *structural differences* between the claimed invention and the prior.

***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (571) 272-1490. The examiner can normally be reached on Monday through Friday from 8:00 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David R. Sample can be reached on (571) 272-1376. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Alicia Chevalier/  
Primary Examiner, Art Unit 1794  
11/9/2009